

Appl. No. 09/580,233
Office Action mailed July 26, 2005
Amendment transmitted December 8, 2005

Attorney Docket No. 10022/15

REMARKS

1. Claims 1-27 are pending in the application. The Examiner is thanked for withdrawing previous rejections under 35 U.S.C. § 103(a).

2. Claims 1-7, 9-10, 17-23 and 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a marketing textbook, *Principles of Marketing*, 8th ed. Prentice Hall, 1999, by Kotler, Philip, and Armstrong ("Kotler"), in view of a published magazine article, *Using Survey Data to Predict Adoption and Switching for Services*, J. of Marketing Research, Feb. 1995, by Samaradasa Weerahandi et al. ("Weerahandi"). Applicants traverse these rejections because, as explained in detail below, the Office Action fails to make out a prima facie case of obviousness against the claims. The Office Action fails to make out a prima facie case of obviousness because the limitations of the claims are not taught or suggested in the references, and the Office Action does not provide evidence of the desirability of combining the references. M.P.E.P. 2143 at 2100-135 (8th ed. rev. 3).

Claim 1

1. The Office Action admits several Claim 1 limitations are not taught or suggested in the references

a. Kotler does not teach or suggest many of the limitations discussed in the rejections. The rejection admits that Kotler does not teach the details of the steps of accepting, accessing, adjusting, estimating and presenting, with limitations as recited in Claim 1. Office Action, pp. 6-7, stating that "Kotler does not teach a method for providing a financial analysis," as claimed and recited in Claim 1. As best Applicants can discern, the terms that are underlined on pp. 6-7 of the Office Action are the limitations that are not found in the references, and which the rejection seems to ignore. In addition, many other claims terms not underlined are also not found in the references.

b. At least the claim term "an adjusted adoption curve," is not found in the references, nor is the step of "adjusting the standard adoption curve to obtain an adjusted adoption curve." The rejection cites Kotler, pp. 156-59, for these limitations. A curve for the time of adoption of innovations on p. 157 of Kotler, Fig. 5-7, is asserted as the claimed "adoption curve." However, there is no teaching or suggestion of how to adapt Kotler's very general curve to an "adjusted" adoption curve based on accepted user-specific input, or the process of moving from the standard

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curve to a curve that is "adjusted" for an enhanced wireless telecommunication service. Kotler does not teach how to adjust an adoption curve, and Kotler does not teach how to adjust an adoption curve by the characteristics of a new product.

The rejection also cites Weerahandi, p. 85, as teaching studying the behavior of customer adoption of new services. Office Action, p. 8, last line, to p. 9, line 5. Weerahandi, however, makes it clear that there is no "enhanced" service. He states that the two products/services "are provided by different supplier groups, both products/services meet similar needs; therefore, a business can switch between them." Weerahandi, p. 85, col. 2, second full paragraph. Thus, if Weerahandi teaches anything, it is much more akin to a "standard" adoption curve rather than an adjusted adoption curve, since no new or "enhanced" service is taught or suggested.

c. The claim limitations of "estimating at least one potential revenue associated with the at least one wireless application," based on "the adjusted adoption curve to generate at least one revenue estimate, and wherein estimating further comprises generating at least one cost estimate based on the first set of cost data values, the second set of cost data values, and the adjusted adoption curve" are not taught or suggested in the references. Kotler is cited for these limitations, the rejection citing pp. 281, and appendix pages A1, A4, and A5. These pages state that a company can estimate minimum and maximum sales. Kotler, p. 281, "Business Analysis" paragraph. The pages in the appendix state that forecasting is important because the company can lose a lot of profit by mis-estimating the market.

These pages of Kotler, however, do not teach or suggest the claim limitations for forecasting or estimating the at least one potential revenue, i.e., based on accepted user-specific input, the revenue data value, the general market data, and the adjusted adoption curve, and also using the first and second set of cost data values and the adjusted adoption curve, as recited in Claim 1. As noted above, Kotler and Weerahandi do not teach an enhanced service or how to adjust an adoption curve. Thus, Kotler and Weerahandi do not teach or suggest the claim 1 limitation of how to estimate the at least one potential revenue associated with a wireless application using an adjusted adoption curve.

d. The claim limitation of "presenting a graphical depiction of a financial analysis," as recited in Claim 1, is not cited in the rejection, and no reference is given for this limitation.

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Accordingly, the rejection of Claim 1 is improper because numerous limitations of the claim are not taught or suggested in the references. The rejection ignores the limitations missing from the references and goes on to state that "it would have been obvious . . . to have modified Kotler for any inclusion, exclusion, selection or organization of user-specific input that the inventor desired." Office Action, p. 7, lines 15-17. The Office Action then includes several more statements on pp. 7-8 to the effect that it would have been obvious to have modified Kotler with a variety of enhancements, which Applicants believe are primarily the underlined terms from pp. 6-7. Thus, the rejection itself admits that the references do not teach or suggest a majority of Claim 1 limitations.

To establish a *prima facie* case of obviousness, first there must be some suggestion or motivation to modify the references or to combine the reference teachings. Even assuming *arguendo* that the Kotler and Weerahandi references **could be** combined/modified, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 at 2100-137, Suggestion or Motivation to Modify the References.

The outstanding Office Action provides as rationale for the combination/modification that "Kotler could have been modified by incorporating" Weerahandi's adoption curve, as well as other limitations. This rationale is expressly discussed in the MPEP as insufficient for establishing *prima facie* obviousness. Therefore, it is respectfully urged that the combination of Kotler and Weerahandi does not establish a proper basis for a rejection of the invention recited in Claims 1-7, 9-10, 17-23 and 25-26.

2. The rejection cites no source for numerous limitations in Claim 1

It is elementary in making a rejection for obviousness that hindsight is not allowed. In particular, the references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention. M.P.E.P. 2141 at 2100-125. The rejection cites Kotler and Weerahandi for several of the claim terms, but, as admitted on pp. 6-7 of the Office Action, a number of terms are not found in either reference. Instead, the rejection makes numerous statements that it would have been obvious to have included the limitations needed to bridge the gap between Kotler and the present invention, stating that "it would have been obvious . . . to have modified Kotler for any

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inclusion, exclusion, selection or organization of user-specific input that the inventor desired.” Office Action, p. 7, lines 15-17. Applicants interpret this to mean that according to the rejection, anything can be added to Kotler and anything can be excluded from Kotler to arrive at a given limitation. No support is made for this assertion.

If there is no source or reference in the rejection for a claim limitation, the source must be the application itself. Thus, hindsight, in which the invention is used against the inventor, may have been used to make the present rejection of Claim 1. Applicants traverse the rejections and request that the Examiner support the assertions in the Office Action with affidavits, as required by 37 C.F.R. § 104(d)(2). In any event, the rejection has not cited a reference for each of the limitations in Claim 1, and thus fails to make out a prima facie case of obviousness for Claim 1. Applicants also request that the rejections make a showing of the desirability of combining the present references or any additional references.

3. The Office Action provides no evidence for the stated desirability of combining the references

The Office Action states in several places that it would be desirable to combine a first reference (e.g., Kotler), “to allow for any inclusion, exclusion, selection, or organization of user-specific input that the inventor desired.” Office Action, p. 7, lines 15-17. For example, the Office Action states that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kotler by incorporating the ability to adjust the adoption curve to provide the more accurate rate of adoption for financial analysis.” Office Action, p. 7, lines 18-21. Other rejections cite published works by Samaradasa Weerahandi, as mentioned above, and also works by Jay Heizer et al. and Carl Townsend.

The Office Action has stated no source for the desirability of the combination of Kotler with another resource or ability as stated in the rejections. If a rejection is based on facts within the personal knowledge of an employee of the Office, the data must be as specific as possible and the reference must be supported, when called for by the Applicant, by the affidavit of such employee, and such affidavit is subject to contradiction or explanation by the affidavits of the Applicant and other persons. 37 C.F.R. § 1.104(d)(2). Applicants traverse the numerous unsupported assertions in the Office Action of the desirability of combining Kotler with another reference, including Weerahandi, Heizer, and Townsend, as further discussed, *infra*, or with an ability, as mentioned

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above. Applicants request that the Examiner provide affidavits in support of the assertions in the Office Action, or withdraw the rejections.

Claims 2-7

Claims 2-7 all recite additional limitations of the adjusted adoption curve. The rejection admits that neither Kotler nor Weerahandi teach any of the additional limitations of Claims 2-7. Office Action, p. 11, line 3, and underlined portions of pp. 11-12. Claim 2, for instance, recites a method "wherein the adjusting step comprises: adjusting the standard adoption curve based on a user input of a selected geographic region from a library of regions and a selected application from a library of applications of the enhanced wireless communications service." As stated, the rejection admits that the Claim 2 limitation, and the limitations of Claims 3-7, are not taught in either Kotler or Weerahandi.

The rejection also cites p. 85 of Weerahandi as teaching adjusting adoption curves. Office Action, p. 13, lines 10-15. Weerahandi, however, makes it clear that there is no "enhanced" service. He states that the two products/services "are provided by different supplier groups, both products/services meet similar needs; therefore, a business can switch between them." Weerahandi, p. 85, col. 2, second full paragraph. Therefore, Weerahandi teaches only studying the behavior of customer adoption of interchangeable services, not new or enhanced services.

The rejection then states that it would have been obvious to modify Kotler in any of the ways described in Claims 2-7 in order to more accurately and correctly reflect the marketplace and its associated demand. The Examiner cites no reference to evidence that Kotler or Weerahandi would be modified precisely as claimed when many other modifications are possible, based on the alleged motivation. This is a clear example of using the claim terms themselves, rather than a reference, to make a rejection.

As admitted in the Office Action, the limitations of Claims 2-7 are not taught or suggested in the references, and the rejections are therefore improper. Applicants also request that the rejections make a showing of the desirability of combining these or any additional references. Applicants respectfully request that the rejections of Claims 2-7 be withdrawn.

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Claims 9 and 10

Claims 9 and 10 are allowable at least because they depend from allowable Claim 1. In addition, Claims 9 and 10 recite additional limitations concerning estimating revenue with a geographic region. The rejection admits that Kotler does not teach or suggest the limitations of Claims 9-10. Office Action, p. 14, last line, to p. 15, line 6. The rejection cites Weerahandi, p. 85 as teaching forecasting demand based on an adoption curve. As discussed above, Weerahandi does not teach or suggest adoption of an enhanced service, only switching between two comparable services. Thus, Weerahandi does not teach an adjusted adoption curve as claimed. Accordingly, Claims 9 and 10 are not taught or suggested in the art cited, and are allowable.

Claims 17-23 and 25-26

The Office Action states that Claim 17 is a system claim that would have been obvious in view of method Claim 1, and is rejected based on the same art and rationale. Claim 17 is indeed a system claim, with limitations different from those of method Claim 1. The "same art" is Kotler and Weerahandi. However, no specifics are given as to the rejections of the Claim 17 limitations. Accordingly, the rejection of Claim 17 is improper and does not make out a prima facie case of obviousness, because the rejection does not cite the specific Claim 17 limitations nor where those limitations are taught or suggested in the prior art.

The Office Action draws the same analogy to Claims 18-23 and 25-26, stating that these claims would have been obvious under the same art and rationale as Claims 2-7 and 9-10. Claims 18-23 and 25-26 are drawn to a system and have limitations different from those of Claims 2-7 and 9-10. Since no specific citations to the prior art are given for the limitations of Claims 18-23 and 25-26, their rejection is improper. The Examiner is respectfully requested to allow Claims 17-23 and 25-26.

3. Claims 8, 11-13, 24 and 27 are allowable at least because they depend from allowable Claim 1 or Claim 17. The Examiner is respectfully requested to withdraw the rejections of Claims 8, 11-13, 24 and 27.

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4. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over a marketing textbook, *Principles of Marketing*, 8th ed. Prentice Hall, 1999, by Kotler, Philip, and Armstrong ("Kotler"), in view of a published magazine article, *Using Survey Data to Predict Adoption and Switching for Services*, J. of Marketing Research, Feb. 1995, by Samaradasa Weerahandi et al. ("Weerahandi"), further in view of a book, *Operations Management*, Prentice Hall, 1999, by Jay Heizer et al. ("Heizer"), and further in view of a book, *Mastering Excel 4 for Windows*, Sybex, 1992, by Carl Townsend ("Townsend").

Applicants traverse the rejection because the Claim 14 limitation of "a bar chart of different variable factors potentially impacting net present value of a business based on the enhanced wire communication service," is not taught or suggested in any of the four references cited from the prior art. The rejection admits that the claim limitations are not taught by Kotler, Weerahandi, or Heizer. Office Action, p. 26, lines 9-16. The rejection states that it is old and well known in the art to chart financial data. However, the rejection does not cite a source for the Claim 14 limitation of "different variable factors potentially impacting net present value of a business." Nor does the rejection cite a reference for the Claim 14 limitation of a graphical representation of these different variable factors. In order to make a prima facie rejection for obviousness, the references must teach or suggest all the limitations of the claims. The references do not teach or suggest the limitations of Claim 14.

Accordingly, Claim 14 is allowable because the limitations of Claim 14 are not taught or suggested in the cited art. The Examiner is respectfully requested to withdraw the rejection of Claim 14.

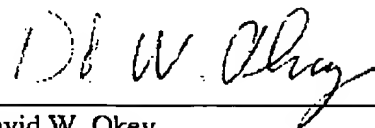
5. Claim 15 is allowable because it depends from allowable Claim 1, and Claim 16 is allowable at least because it depends from allowable Claim 15. The Examiner is respectfully requested to withdraw the rejections of Claims 15-16.

6. Applicants request the Examiner to withdraw the present rejections and to advance the application to allowance. The Examiner is respectfully requested to telephone the below-listed attorney at 312-321-4200 if such communication would expedite this application or would be helpful to the Examiner.

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Respectfully submitted,



David W. Okey
Registration No. 42,959
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
One Indiana Square, Suite 1600
Indianapolis, IN 46204
Telephone: 317-636-0886
Facsimile: 317-634-6701